



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/284,862 04/22/99 KURIYAMA H 500.37156X00

020457 IM52/1017
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EXAMINER

BEX, P

ART UNIT

PAPER NUMBER

1743

DATE MAILED: 10/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/284,862

Applicant(s)

KURIYAMA ET AL.

Examiner

P. K. Bex

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7 and 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 02 August 2001 is: a) ☐ approved b) ☒ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The cancellation of claims 2, 4 and 8, and the addition of claims 15-17 is acknowledged and has been entered into the record.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "30a" and "33" have both been used to designate the "transparent cover", see page 9, line 14 and page 16. Correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3, 5-7, 9-17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, line 4, the new limitation "at least two analyzing parts having different functions" is not supported within the specification. The specification describes the analyzers 3, and 4 as "analyzing parts", there is no mention as to what *functions* these analyzers 3 and 4 perform. Therefore, it is not definite as to whether these have *different* or *similar* functions. Same deficiency was found in claims 6 and 12.

Claim 12, lines 6-9, disclose "stages...at a height of 750 to 850 mm measured from the floor" is not disclosed within the instant specification. The specification recites the height

distance from the floor to the stage on the analyzer as h2. This height, h2, is defined as the range 850-950 mm, see page 13, line 10 (Figures 3-4), not 750 to 850 mm as currently claimed.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1, 3, 6-7, 9, 15-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Takahashi *et al* (JP 2000-9738).

Takahashi *et al* teach a modular analyzer system comprising a specimen rack 10, a specimen introducing part 50, a specimen rack conveyor 30 positioned longitudinally along the plurality of removable analyzers, i.e. buffer, centrifuge, destoppler, etc. 2a-b, 3-9 (Fig. 1, 4ab-c, 5-7f). Additionally, each analyzer comprising a take-in buffer and discharge part 24-29 and a storage part for storing the specimen rack. The modular system comprising identification parts 16 at intervals equal to the length of the specimen rack (Fig. 6). Note: Takahashi *et al* teach stages 65 on the top surface the analyzing units (Fig. 3).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1, 3, 5-7, 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wakatake (USP 5,380,488) in view of (JP 62-1603).

Wakatake anticipate the instant claims by teaching an modular analyzer system comprising a specimen rack 2, a specimen introducing part Y1, a specimen rack conveying parts 10, 15, 25, a storage part for storing the specimen, three analyzers D1-D3, wherein the introducing part, the storage part Y4 and the analyzers are independent of each other (column 2, line 61-62), the analyzers each comprising pipette assembly (column 3, lines 35-65) and allowing the specimen to react with a reagent. The specimen introducing part, analyzers and storage parts are arranged and couple along the longitudinal direction of the conveyers (Fig1). Wakatake teach that it is possible to provide a plurality of analyzers for performing a first item of analysis and a plurality of other analyzers for performing a second time of analysis (column 6, line 65- column 7, line 10). Note: Wakatake teach a reexamining buffer for temporarily holding a specimen after analysis is complete. Additionally, Wakatake teaches that each analyzer includes a take-in buffer, a specimen rack discharge part (column 3, line 66- column 4, line 3). It is inherent within the "modular" system of Wakatake that the independent units are equal in height and depth, so that it is possible to avoid the high cost that would arise from special ordering an

entire analyzing system. This allows for versatility of the system by incorporating as many analyzers as needed to meet the scale of delivery desired (column 6, lines 55-62).

Wakatake does not disclose the use of identification means and patterns on the front of the modular units. However, JP 62-1603 does teach the use of a function identification means 17 on the front of an analyzer 14 (Fig. 1). Accordingly, it would have been obvious to one of ordinary skill in the art to include in on the units of Wakatake an identification and pattern on the front of a modular unit, as taught by JP 62-1603, in order to identify analysis procedure of the units without having to open the cover of the equipment.

With respect to the specific heights and depths of the units, one of ordinary skill in the art would have found it obvious to have provided the modular units of Wakatake with a particular height and depth, in order to optimize the ability of the average observer to work at the units. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

9. Claims 5, 10-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi *et al* (JP 2000-9738).

Takahashi *et al* as previously discussed above, do teach the adjustment of the various modular components via height adjusting screws 71. Additionally, Takahashi *et al* do teach modular components 50, 5a-b8-9 and 60 having the same widths, i.e. A (Fig. 2). However, Takahashi *et al* do not teach the specific widths of the rack conveying part, specimen introducing part, analyzing part and specimen storage parts having heights within the range of 850-950 mm as measured from the floor surface. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to have adjusted the height of the modular components of Takahashi *et al* with a particular height and depth, in order to optimize the ability of the average observer to work at the units. Additionally, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

10. Claim 1, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okamoto *et al* (JP 63-217273).

Okamoto *et al* teach an modular analyzer system comprising a specimen rack 30, a specimen introducing part 12, a specimen rack conveying parts 14A-B, a storage part for storing the specimen 24, three analyzers 18A-B wherein the introducing part, the storage part and the analyzers are independent of each other (Fig. 1, 4-6), the analyzers each comprising pipette assembly and allowing the specimen to react with a reagent. The specimen introducing part, analyzers and storage parts are arranged and coupled along the longitudinal direction of the conveyers (Figs.1-2). Note: Okamoto *et al* teach stages 20A on the top surface of the supply, storage and analyzing parts (Figs. 1, 3).

Okamoto *et al* fails to explicitly state that stages have a color which is different from that of the housing. It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of the invention to color code the stages. Such use of color-coding allows for quick and distant identification of the units.

Response to Arguments

11. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. See above Office Action.

Conclusion

12. No claims allowed.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays from 6:30 am to 4:00 pm EST.

The fax number for the organization where this application or proceeding is assigned is (703) 305-7718 for official papers prior to mailing of a Final Office Action. For official papers after mailing of a Final Office Action, use fax number (703) 305-3599. For unofficial or draft papers use fax number (703) 305-7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



P. Kathryn Bex
Patent Examiner
AU 1743
October 11, 2001


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